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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/723,098	11/27/2000	Modasser H. Shohany	13093	5348

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EXAMINER

YOON, TAE H

ART UNIT	PAPER NUMBER
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1714

16

DATE MAILED: 03/04/2003

Please find below and or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/22/09

Applicant(s)

EI-Shoubary & d

Examiner

T. Yoon

Group Art Unit

1714

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 2-11-03
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 68-95 is/are pending in the application.
- ☐ Of the above claim(s) is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☒ Claim(s) 68-95 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 68 and 71-77 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over DE 1234234.

DE teaches the instant pigments treated with an organic-acid phosphate compound in examples 3 and 4 which meets the instant formula of claim 3. Dried pigments and various acids are taught at page 1, lines 4 and 23-26 of the translated paper.

Thus, the instant invention lacks novelty.

The recitation of "consisting essentially of" alone cannot overcome the rejection based on the art reciting "comprising". See *In re De Lajarte*, 337 F.2d 870, 143 USPQ 256 (CCPA, 1964); *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461 (CCPA 1976); *In re Janakirama-Rao*, 317 F.2d 951, 137 USPQ 893 (CCPA 1963); When applicant contends that modifying components in the reference composition are excluded by the recitation of "consisting essentially

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of", applicant has the burden of showing the basic and novel characteristics of his composition - i.e. a showing that the introduction of these components would materially change the characteristics of applicant's composition.

The intended use, plastics applications, has no probative value, and paints of DE which yield a thin film on a substrate meeting the instant plastics applications in fact.

Claims 68-77, 92 and 94 are rejected under 35 U.S.C. 103(a) as obvious over DE 1234234 in view of McClain (US 4,287,333) or Stramel (US 5,397,391).

The instant invention further recites polyethylene, copolymers of ethylene, polypropylene, polycarbonates and polystyrene over DE.

However, DE teaches the use of the organo-acid phosphate treated pigment in a paint composition at page 1, line 1 and in examples 5 and 6 of the translated copy. McClain teaches the use of polyethylene in a coating composition at col. 7, line 61 to col. 8, line 16 and in table III, and Stramel teaches the use of the instant polymers in a coating (paint) composition at col. 2, lines 44-51 and at col. 4, lines 52-63 wherein poly(vinylaromatic) resins encompass the instant polystyrene.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to utilize the organo-acid phosphate treated pigment of DE in a coating composition comprising the instant polymers of McClain or Stramel since DE teaches the use of the organo-

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acid phosphate treated pigment in a paint composition and since the use of the instant polymers in a coating (paint) composition is a routine practice as taught by McClain and Stramel.

Claims 68, 71-78, 81-87 and 90 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Menovcik et al (US 5,876,493).

Menovcik et al teach the instant pigments treated with an organic-acid phosphate compound at col. 3, lines 1-22. The method of treatment and pre-treated pigments are taught at col. 1, lines 52-57 and col. 3, lines 62-63. Various polymers and neutralizing agents such as dimethylethanol amine are taught at col. 4, lines 25-37. Also, see above case-laws.

Thus, the instant invention lacks novelty.

Claims 68-95 are rejected under 35 U.S.C. 103(a) as obvious over Menovcik et al (US 5,876,493) in view of McClain (US 4,287,333), Stramel (US 5,397,391), Yaginuma et al (US 3,920,769) or Orth-Gerber et al (US 6,340,387).

The instant invention further recites polyethylene, copolymers of ethylene, polypropylene, polycarbonates and polystyrene, and metal oxide, polyalcohol and triethanolamine over Menovcik et al.

However, Menovcik et al teach the use of any polymeric resin for a coating composition and of amine neutralizing agents at col. 4, lines 31-37. The use of an alcohol in milling or

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grinding is taught in example 2 and example 3 shows the use of mixed pigments and flow control agent.

McClain teaches the use of polyethylene in a coating composition at col. 7, line 61 to col. 8, line 16 and in table III, and Stramel teaches the use of the instant polymers in a coating (paint) composition at col. 2, lines 44-51 and at col. 4, lines 52-63 wherein poly(vinylaromatic) resins encompass the instant polystyrene.

Yaginuma et al teach the instant triethanolamine as a neutralizing agent and equate said triethanolamine and dimethylethanol amine of Menovcik et al at col. 4, lines 29-31, and Orth-Gerber et al teach the instant trimethylpropane as a grinding aid in table 2.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to utilize the organo-acid phosphate treated pigment of Menovcik et al in a coating composition comprising the instant polymers of McClain or Stramel since Menovcik et al teach the use of any polymeric resin and since the use of the instant polymers in a coating (paint) composition is a routine practice as taught by McClain and Stramel, or to utilize triethanolamine of Yaginuma et al as a neutralizing agent or trimethylpropane of Orth-Gerber as a grinding aid in Menovcik et al since Menovcik et al teach employing a neutralizing agent and an alcoholic grinding aid.

With respect to claim 88, Menovcik et al teach the use of mixed pigments and flow control agent, and thus the use of aluminum oxide as a pigment or silicon dioxide (silica) as a flow control (thixotropic) agent would be obvious.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (703) 308-2389. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

THY/March 3, 2003


TAE H. YOON
PRIMARY EXAMINER